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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,585	12/20/2006	Laurent Dubedout	291613US6PCT	5553
22850 7590 02/08/2010 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER WILLIAMS, ROBERT H.				
ART UNIT 3679		PAPER NUMBER		
NOTIFICATION DATE 02/08/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/580,585

Applicant(s)

DUBEDOUT ET AL.

Examiner

Robert Williams

Art Unit

3679

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ ~~Notes of Informal Patent Application~~
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Group I, claim(s) 1-17, drawn to an assembly of two expandable threaded tubular joints.

Group II, claim(s) 18 and 19, drawn to a method for assembling two expanded tubular joints.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the common technical feature between the groups is an initial assembly according to claim 1. This cannot be a special technical feature under PCT Rule 13.2 because the elements are known in the prior art. PCT Application Publication WO 98/42947, Metcalfe, teaches an assembly of two expandable threaded tubular joints substantially as claimed in claim 1.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

4. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See

MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

5. Claims 18 and 19, as amended, are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claims properly presented in the application as filed were drawn only to the product of Group I, original claims 18 and 19 were not subject to examination on the merits because they contained improper multiple dependencies.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 18 and 19 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

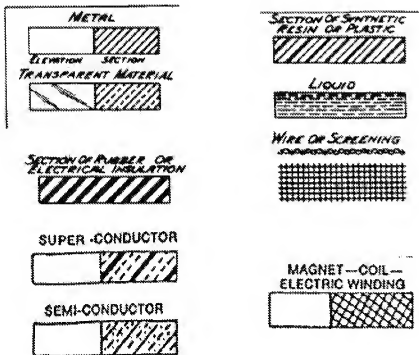
Specification

6. Receipt of amendments to the specification on 11/11/09 is acknowledged. The abstract is acceptable.

Drawings

7. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the axial clearance between the stabbing flanks of claim 14 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

The drawings are objected to as failing to comply with 37 CFR 1.84(h)(3) because the parts in cross section must show proper material(s) by hatching with regularly spaced parallel oblique strokes. The various parts of a cross section of the same item should be hatched in the same manner and should accurately and graphically indicate the nature of the material(s) illustrated in cross section. Figures 1 and 3-11 contain section views without hatching. A sample of standard hatching patterns, which are fully set forth in MPEP 608.02(IX), is provided below. Appropriate correction is required for all drawings.



Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing

date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1, 8, 10, 11, and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Regarding claim 1, the limitation "an annular zone having an initial reduced thickness selected such that the section of the sleeve in the region of this zone is greater than or equal to the product of the section of a common portion of said tubes and each abutment surface" renders the claim indefinite because it is unclear what quantities are being multiplied. Moreover, the limitation appears to be only a recitation of the process by which the annular zone is formed, i.e., a product-by-process limitation. As a result, patentability will be determined based on the annular zone without regard for the recited method steps. MPEP 2113.

11. Claim 8 recites the limitation “said curvilinear portions.” There is insufficient antecedent basis for this limitation in the claim. Note that while claim 7 sets forth “at least two curvilinear portions,” claim 8 depends from claim 1, and thus claim 7 cannot provide antecedent basis for claim 8. For examination purposes in this action only, claim 8 will be treated as if it depends from claim 7.

12. Regarding claim 10, the limitation “the two curvilinear portions are separated by a substantially cylindrical central portion” renders the claim indefinite because it is unclear what structure is being claimed. How is the cylindrical portion different than the curvilinear portions, when cylinders are curved as well? As shown in Fig. 4, the central portion appears to be a flat or straight-line portion.

13. Regarding claim 15, the terms “conical-type and cylindrical-type threads” render the claim indefinite because it is unclear what structure is being claimed. The use of the word “type” implies that the terms encompass more than just conical and cylindrical threads, but it is not clear what else would be included.

Claim Rejections - 35 USC § 102

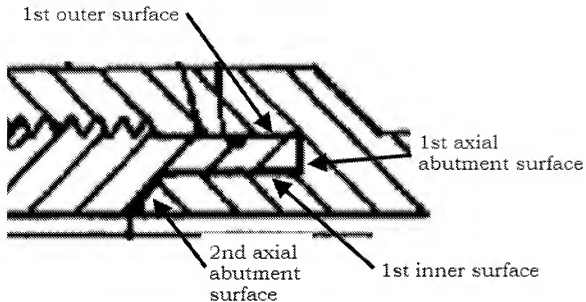
14. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

15. Claims 1 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by PCT Application Publication WO 98/42947, Metcalfe, hereafter, "Metcalfe '947."

16. Regarding claim 1, Metcalfe '947 discloses an assembly of two expandable threaded tubular joints, disposed symmetrically (page 8, lines 11-21, "The assembly ... allows lengths of expandable tubing to be connected to form a string, [and] comprises a tubular connector ... utilized to join the ends of two lengths of expandable tubing," Fig. 2, #20, 21, 24, 25) and each comprising,

a first tubular element arranged at an end of a tube and comprising a first portion, provided with a male thread (page 9, line 3, "threads on the outer surface of the tubing," Fig. 2 #24, 28), and a second portion extending said first portion (page 9, lines 3-4, "Inwardly of the threads, the end portions," Fig. 2 #20, 21) and comprising:

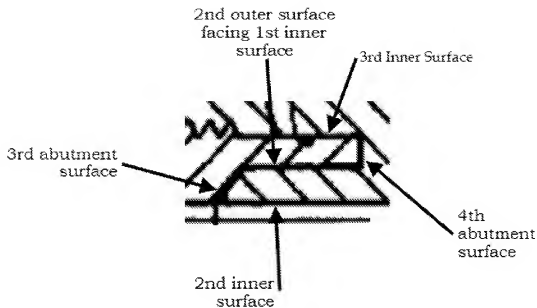
- i) a first outer surface,
- ii) a first annular lip having a first axial abutment surface and a first inner surface and delimited by said first outer surface over a portion of the axial length thereof, and
- iii) a second abutment surface (page 9, lines 5-6, "corresponding tongues provided on the ends of the tubing lengths," Fig. 2 #32, and as shown below);



and,

a second tubular element (20) comprising:

- i) a female thread, matching the first male thread and screwed thereto (page 9, lines 1-3, "inner walls of each connector end portion define threads for engaging corresponding threads on the outer surface of the tubing," Fig. 2 #26, 27),
- ii) a second annular lip, having a third abutment surface, a second outer surface, configured to be arranged to face said first inner surface, and a second inner surface, and wherein
- iii) a third inner surface and a fourth axial abutment surface defining with the second outer surface an annular recess matching and receiving the corresponding first lip (Fig. 2, as shown below),



wherein said second tubular elements form two opposing ends of a female/female-type connection sleeve (page 8, line 14, "tubular connector," Fig. 2 #16), separated by a central portion (page 8, lines 17-18, "intermediate portion," Fig. 2 #22) initially provided, over an outer surface, with an annular zone having an initial reduced thickness (page 8, lines 26-28, "the connector end portions are upset, that is they include portions of greater wall thickness than the tubing and are of a greater diameter than the tubing," Fig. 2) and each second abutment surface rests against the corresponding third abutment surface and/or in that each abutment surface rests against the corresponding fourth abutment surface (Fig. 2, and as shown above), and

wherein the assembly is configured to develop, after diametral expansion in the plastic deformation region, sealing interference contacts sealing the assembly (where the first tubular element, 24, of Metcalfe '947 is sealed to the second tubular element, 20, by the interengagement of their threads, 26 and 28, and of their tongue, 30, and groove, 32).

17. Regarding claim 15, Metcalfe '947, as applied to claim 1 above, further discloses male and female threads selected from a group consisting of conical-type and cylindrical-type threads and each formed over at least one tubular element portion (see Fig. 2).

18. Regarding claim 16, Metcalfe '947, as applied to claim 1 above, further discloses a first outer surface and third inner surface are shaped in such a way that, after expansion, a sealing interference contact is defined between a portion of each of them (see the annotated Fig. 2, above).

19. Regarding claim 17, Metcalfe '947, as applied to claim 1 above, further discloses a first and second expandable tubular elements shaped in such a way that, after said expansion, a sealing interference contact is defined between an inner end portion of said first lip and said second outer surface (see the annotated Fig. 2, above).

Claim Rejections - 35 USC § 103

20. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
21. Claims 2-5 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Metcalfe '947.
22. Regarding claim 2, Metcalfe '947, as applied to claim 1 above, further discloses a zone of reduced thickness in the form of a dish provided with a central portion having said maximum reduced thickness and lateral walls (see Fig. 2), but does not disclose the lateral walls inclined at an angle of less than approximately 30°. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a transition from the intermediate portion to the end portions at a low angle of inclination, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Please note that in the instant application, page 4, lines 3-4, applicant has not disclosed any criticality for the claimed limitations.

Moreover, the variation of the angle of inclination of the lateral walls amounts to nothing more than a change of the shape of the sleeve. Changing the shape of the

sleeve of Metcalfe '947 would have been obvious to one of ordinary skill in the art.

MPEP 2144.04.

23. Regarding claim 3, Metcalfe '947, as applied to claim 2 above, does not disclose said angle equal to approximately 15°. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a transition from the intermediate portion to the end portions at a low angle of inclination, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Please note that in the instant application, page 4, lines 3-4, applicant has not disclosed any criticality for the claimed limitations.

Moreover, the variation of the angle of inclination of the lateral walls amounts to nothing more than a change of the shape of the sleeve. Changing the shape of the sleeve of Metcalfe '947 would have been obvious to one of ordinary skill in the art.

MPEP 2144.04.

24. Regarding claims 4 and 20, Metcalfe '947, as applied to claim 2 above, further discloses a dish extending substantially in a zone between last threads of the two female threads, as shown in Figure 2.

25. Regarding claim 5, Metcalfe '947, as applied to claim 4 above, further discloses a dish extending substantially between said third abutment surfaces of the two second tubular elements, as shown in Figure 2.

26. Claims 6-11 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Metcalfe '947 as applied to claims 1-5 and 20 above, and further in view of U.S. Patent 6,478,344, Pallini, Jr., et al., hereafter, "Pallini '344."

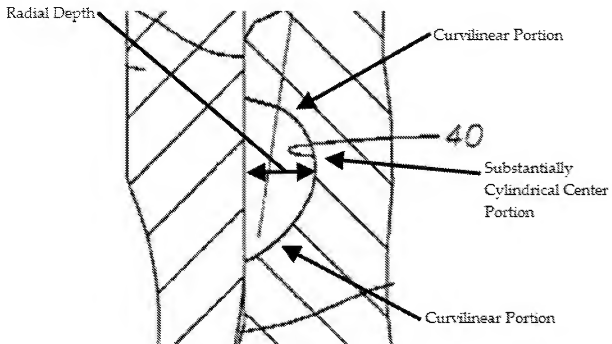
27. Regarding claims 6 and 21, Metcalfe '947, as applied to claims 1 and 2 above, discloses a second tubular element, but does not disclose the second tubular element comprising, at a selected location of its third inner surface, an inner annular groove, arranged substantially in the region of said first outer surface.

Nevertheless, Pallini '344 teaches that it is known to use a second tubular element comprising an inner annular groove (40 and 42) in the relevant art.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the second tubular element of Metcalfe '947 with an inner annular groove as taught by Pallini '344, in order "to reduce the instance of stress fractures, thereby improving the fatigue life of the connection." Pallini '344, abstract.

28. Regarding claims 7, 8, 10, and 11, the combination of Metcalfe '947 and Pallini '344, as applied to claim 6 above, further discloses said groove initially comprises at

least two curvilinear portions (Pallini '344, as shown in the annotated Fig. 3 below, where the radii of the curvilinear portions are substantially identical).



29. Regarding claim 9, the combination of Metcalfe '947 and Pallini '344, as applied to claim 8 above does not explicitly disclose a radius of curvature initially between approximately 2 mm and approximately 20 mm.

Nevertheless, changing the radius of curvature of the curvilinear portions of the combination of Metcalfe '947 and Pallini '344 would have been obvious to one of ordinary skill in the relevant art at the time the invention was made because it is nothing more than a change of shape. MPEP 2144.04. Please note that in the instant

application, page 10, lines 1-2, applicant has not disclosed any criticality for the claimed limitations.

30. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Metcalfe '947 as applied to claim 1 above, and further in view of U.S. Patent 5,462,315, Klementich, hereafter, "Klementich '315."

Metcalfe '947, as applied to claim 1 above, does not disclose threads provided with a carrier flank having a negative angle of between approximately -3° and approximately -15° (claim 12) and a stabbing flank having a positive angle of between approximately $+10^{\circ}$ and approximately $+30^{\circ}$ (claim 13).

Nevertheless, it is old and well known per se in the relevant art to use a carrier flank having a negative angle of between approximately -3° and approximately -15° and a stabbing flank having a positive angle of between approximately $+10^{\circ}$ and approximately $+30^{\circ}$, as evidenced by Klementich '315 (see Figs. 6A-6D, illustrating that it is known in the art to select the claimed flank angles from among a finite set of known alternatives).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the threads of Metcalfe '947 with flank angles such as those taught by Klementich '315.

31. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Metcalfe '947 and Pallini '344 as applied to claim 13 above, and further in view of U.S. Patent 5,419,595, Yamamoto et al., hereafter, "Yamamoto '095."

The combination of Metcalfe '947 and Pallini '344, as applied to claim 13 above, does not disclose male and female threads arranged to have, after screwing and prior to expansion, an axial clearance between their stabbing flanks of between approximately 0.05 mm and approximately 0.3 mm.

Nevertheless, it is old and well known per se in the relevant art to use an axial clearance between stabbing flanks, as evidenced by Yamamoto '095 (column 2, lines 23-25, "dimensional tolerances for API standards allow a gap of from 0.03 to 0.19 mm between the stab flanks").

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the flanks of Metcalfe '947 with an axial clearance such as those taught by Yamamoto '095.

Double Patenting

32. Claims 1, 6-19, and 21 are provisionally rejected under the judicially created doctrine of obvious-type double patenting as being unpatentable over claims 1, 2, 12-

17, 23-25, 30, 31, 32, and 36 of copending application No. 10/580,607 and claims 1, 10-12, 15, 18-23, 25, 26, 36, and 41 of copending application No. 10/580,718.

33. Regarding the claims of the '607 application, the scope of claim 1 therein is nearly identical to that of claim 1 in the instant application, with the addition of two limitations "first tubular element comprises a selected local annular added thickness in the region of a fourth inner surface extending the second abutment surface," which is disclosed but not claimed in the instant application (Fig. 3, SA1), and "said second tubular element comprises, at a selected location of said third inner surface, an inner annular groove arranged substantially in the region of to face, in a radial direction, said first outer surface," which is substantially the same as claims 6 and 21 in the instant application. The elements of claim 1 in the instant application that are not found in claim 1 of the '607 application, the "sleeve(M)," "central portion (PCM)," and "annular zone(G2)," are claimed in claims 30 and 31 of the '607 application, which depend from claim 1 therein.

Claim 2 in the '607 application is substantially the same as claims 16 and 17 of the instant application.

Claim 12 in the '607 application is substantially the same as claim 7 of the instant application.

Claim 13 in the '607 application is substantially the same as claim 8 of the instant application.

Claim 14 in the '607 application is substantially the same as claim 9 of the instant application.

Claim 15 in the '607 application is substantially the same as claim 10 of the instant application.

Claim 16 in the '607 application is substantially the same as claim 11 of the instant application.

Claim 17 in the '607 application is substantially the same as claim 15 of the instant application.

Claim 23 in the '607 application is substantially the same as claim 12 of the instant application.

Claim 24 in the '607 application is substantially the same as claim 13 of the instant application.

Claim 25 in the '607 application is substantially the same as claim 14 of the instant application.

Claim 32 in the '607 application is substantially the same as claim 18 of the instant application.

Claim 36 in the '607 application is substantially the same as claim 19 of the instant application

34. Regarding the claims of the '718 application, the scope of claim 1 therein is nearly identical to that of claim 1 in the instant application, with the additional limitation "wherein said second and third abutment surfaces are conical surfaces having substantially identical angles of inclination relative to a plane transverse to a longitudinal direction, selected so as to allow said second abutment surface to rest against said third abutment surface, generating a first radial and sealing interference contact of one of said first inner and outer surfaces of the first lip against said second outer surface or said third inner surface respectively," which is disclosed but not claimed in the instant application (page 12, lines 20-28). The elements of claim 1 in the instant application that are not found in claim 1 of the '718 application, the "sleeve(M)," "central portion (PCM)," and "annular zone(G2)," are claimed in claims 25 and 26 of the '718 application, which depend from claim 1 therein.

Claim 10 in the '718 application is substantially the same as claim 12 of the instant application.

Claim 11 in the '718 application is substantially the same as claim 13 of the instant application.

Claim 12 in the '718 application is substantially the same as claim 14 of the instant application.

Claim 15 in the '718 application discloses a groove (G1) substantially the same as that of claim 6 of the instant application.

Claim 18 in the '718 application is substantially the same as claim 7 of the instant application.

Claim 19 in the '718 application is substantially the same as claim 8 of the instant application.

Claim 20 in the '718 application is substantially the same as claim 9 of the instant application. Note that where the range claimed in claim 9 ("between approximately 2mm and approximately 20 mm") overlaps the range in claim 20 ("between approximately 2mm and approximately 60 mm"), a *prima facie* case of obviousness exists. MPEP 2144.05.

Claim 21 in the '718 application is substantially the same as claim 10 of the instant application.

Claim 22 in the '718 application is substantially the same as claim 11 of the instant application.

Claim 23 in the '718 application is substantially the same as claim 15 of the instant application.

Claim 36 in the '718 application is substantially the same as claim 18 of the instant application.

Claim 41 in the '718 application is substantially the same as claim 19 of the instant application.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter of the application claims is fully disclosed in the patent application and covered by patented claims. The patented claims are inclusive for they are drafted using the "comprising-style" format and cover the subject matter of the application claims. Since application claims has obtained the right to exclude others from making or using the subject matter set forth in the claims of this application by virtue of the patented claims, the issuance of the application into the patent without a terminal disclaimer as provided for under 37 CFR section 1.321 (b) would amount to an extension of this right.

This is a provisional obvious-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

35. Applicant's arguments filed 11/11/09 have been fully considered but they are not persuasive.

36. In response to applicant's argument on pages 11-13 that Metcalfe '947 fails to show "sealing interference contacts sealing the assembly," it is first noted that the assembly is defined in claim 1 as "an assembly of two expandable threaded tubular joints." Thus, when the claim later recites "sealing the assembly," it follows that what is being sealed is the joints, i.e., the area of interface between the tubular elements, not the tubular elements. Applicant's argument is directed to a feature that is not claimed, i.e., a seal between the tubular elements and the external environment. Rather, all that is required by the claim is that the assembly itself is sealed, as in Metcalfe '947, where the joint members are sealed to one another.

37. Applicant argues on page 13 that Metcalfe '947 fails to recognize that the angle of the walls of the intermediate portion is result-effective, and as a result, it would not have been obvious to optimize the angle.

First, Metcalfe '947 discloses lateral walls inclined at an angle, which appears to be 45 degrees based on the drawings. However, patent drawings are not to scale, so Metcalfe '947 does not preclude angles other than 45 degrees. Further, claim 2 recites "an angle of less than *approximately* 30°," (emphasis added) which does not preclude angles greater than 30 degrees, for example, any angle between 30 and 60 degrees could be interpreted as "approximately" 30 degrees, since it would be closer to 30 degrees than to 90 degrees. Therefore, the angle of the walls shown in Fig. 2 of Metcalfe '947

could even anticipate the claimed “angle of less than *approximately* 30’,” and clearly makes obvious a minor structural change to a feature that applicant has not disclosed as critical.

Second, one of ordinary skill in the art would plainly recognize, without the need for an explicit teaching, that the material thickness of an element directly correlates to its strength and to the amount of force required to deform that element. It naturally follows that the angle of transition from a thicker portion to a thinner portion alters these factors, and as such the angle is inherently result-effective in a joint that is subjected to axial and/or radial forces. Therefore, one of ordinary skill in the art would have found it obvious at the time the invention was made to determine the optimal value of this angle through routine experimentation.

Further, applicant cannot rely on *In re: Antonie* (559 F.2d 618, 195 USPQ 6, CCPA 1977) because *Antonie* sets forth an exception to the rule of *In re: Aller* (105 USPQ 233) but does not override the rule, and the *Antonie* exception is not applicable to the instant application. “This case, in which the parameter optimized was not recognized to be a result-effective variable, is another exception,” *Antonie* at 9. The *Antonie* exception is limited to cases where the applicant recognizes a result-effective variable that is not recognized as such in the prior art. “In this case, the invention as a whole is the ratio value of 0.12 *and* its inherent and disclosed property,” (emphasis in original) *Id.* at 8. In

the instant application, it cannot be said that the claimed angle represents applicant's "invention as a whole," because applicant has not disclosed any properties resulting from the claimed angle, let alone recognized it as result-effective. See page 3, line 32 to page 4, line 4 of the instant specification, "The assembly according to the invention **may comprise** other characteristics which **may be taken individually or in combination**, in particular ... the zone of reduced thickness in the form of a dish **may be provided** with a central portion having the maximum reduced thickness and lateral walls inclined at an angle of less than approximately 30° and **preferably** equal to approximately 15°" (emphasis added). Thus, the result-effective exception set forth in *Antonie* does not remove the instant application from the general rule of *Aller*.

Lastly, the variation of the angle of inclination of the lateral walls amounts to nothing more than a change of the shape of the sleeve. Changing the shape of the sleeve of Metcalfe '947 would have been obvious to one of ordinary skill in the art. MPEP 2144.04.

Conclusion

38. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. New grounds were necessitated because the amendment now requires examination of the subject matter in claims not previously properly presented

due to improper multiple dependency. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Williams whose telephone number is (571)270-1155. The examiner can normally be reached on Mon-Thurs 9:30-7:00, Fri 9:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. W./
Examiner, Art Unit 3679
1/8/2010

/Daniel P. Stodola/
Supervisory Patent Examiner, Art Unit 3679